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EXAMINER

DAZENSKI, MARC A

ART UNIT	PAPER NUMBER
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2621

NOTIFICATION DATE	DELIVERY MODE
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10/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/572,873	Applicant(s) IKEDA ET AL.	
	Examiner MARC DAZENSKI	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6-18-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 25 June 2009 have been fully considered but they are not persuasive.

On page 9 of the remarks, Applicant argues, "an object described in the Java language is different between the present language and Tsumagari et al," as well as "suppose ENAV contents (30) of Tsumagari et al is asserted as corresponding to this 'application,' Tsumagari et al would then lack any corresponding element to an operation mode object." The examiner respectfully disagrees, and also notes that nowhere in claim 15 does it say that the "application" is "an operation mode object." Rather, line 10 of the claim merely states that there are files that compose applications and further that there is a title "corresponding" to the second operation mode object. The examiner therefore maintains that the originally cited sections of Tsumagari et al do in fact read on the limitations of claim 15 (i.e., the ENAV contents 30 read on the "application" and the ENAV playback information reads on the claimed "second operation mode object").

On page 9 of the remarks, Applicant argues, "the instruction provided to the playback device is different between the present invention and Tsumagari et al," as well as "the ENAV playback information according to Tsumagari et al does not instruct the playback device to read which file of a plurality of files composing applications stored in a cache." The examiner respectfully disagrees, and notes that a careful reading of

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claim 15 reveals that nowhere does it disclose that the plurality of files composing application are *stored in a cache*, but rather that the cache management information shows which file is to be read to a cache at a certain time (i.e., the files need not be previously stored in the cache, as it appears Applicant is arguing). Therefore, Applicant's argument is considered moot, and the examiner maintains his original rejection.

On page 10 of the remarks, Applicant argues "Tsumagari et al lacks any disclosure of a cache," as well as, "Tsumagari is silent with regard to any reading of content into a cache." The examiner respectfully disagrees, and notes that paragraph [0073] of Tsumagari discloses "an ENAV playback control method being read and stored in a memory in advance" so that the ENAV data body can be read without a delay, and the ENAV playback information is read prior to the ENAV contents data body. Though not explicitly exhibited in figure 1, the examiner maintains that the only way for contents to be "stored in a memory in advance" is if there is some memory means comprised within the DVD-Video player of figure 1, and further that it is acting as a cache. Therefore, the examiner maintains his original rejection.

A full rejection of the pending claims appears below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 12/110,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claims 15-18 are merely encompass broader subject matter of claims 1-4 of 12/110,452 (i.e., the entirety of claims 15-18 are found within claims 1-4).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

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Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 15 defines a recording medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or computer-readable memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program.

Note:

A "signal" (or equivalent) embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Claim Rejections - 35 USC § 112

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 provides for the use of a recording method for generating volume data and obtaining a recording medium that stores the volume data thereon but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsumagari et al (US PgPub 2003/0161615), hereinafter referred to as Tsumagari.

Regarding **claim 15**, Tsumagari discloses enhanced navigation system using digital information medium. Further, Tsumagari discloses a DVD video disc (1) comprising DVD-Video contents (10) as well as ENAV contents (30), the contents (10) comprising VMG/VTSI which is control data for one or more video contents VTS#1-VTS#n as well as the contents (30) allowing a user to play back the contents of each VTS by a method different from VMG/VTSI prepared by the provider and to play back while adding contents different from VMG/VTSI prepared by the provider, which reads on the claimed, "a recording medium storing thereon an index table and a plurality of operation mode objects," as disclosed at paragraphs [0058], [0062], and [0064]-[0065]; wherein:

ENAV contents (30) comprise playback information which contains a markup language, script language or the like, which describes playback methods of the ENAV contents data body and/or DVD-Video contents (10), the language used as the playback control information may be JavaScript, which reads on the claimed, "the index table shows a plurality of titles in correspondence with the plurality of operation mode objects, at least one of the operation mode objects being a first operation mode object that is for use in a movie mode, and at least another one of the operation mode objects being a second operation mode object that is for use in a virtual machine," as disclosed at paragraphs [0064]-[0066];

each title in DVD-Video disc (1) comprising playback control information PGCI in VTSI, which reads on the claimed, "the first operation mode object includes a navigation command that shows a control procedure," as disclosed at paragraph [0063]; and,

the ENAV playback information can contain file information of the ENAV contents (information of a file to be referred to, and information of a file to be referred to instead if the file to be referred to is not present or if a player does not have a function of decoding the file if that file is present), synchronization information (information used to control to play back the DVD-Video contents in connection or combination with that of the ENAV contents at a predetermined timing), and duration information (information indicating the display time range or timing range of the ENAV contents), which reads on the claimed, "the second operation mode object includes cache management information, and the cache management information shows, of files that compose applications, which file is to be read to a cache before audio-visual playback of the title corresponding to the second operation mode object when said title becomes a current title," as disclosed at paragraph [0067].

Regarding **claim 16**, Tsumagari discloses enhanced navigation system using digital information medium. Further, Tsumagari discloses DVD-Video player (100) which plays back the contents of DVD-Video disc (1) comprising DVD-Video contents (10) and ENAV contents (30), which reads on the claimed, "a playback apparatus that performs playback of a title recorded on a recording medium, and execution of an application," as disclosed at paragraph [0058] and exhibited in figure 1; the apparatus comprising:

video playback engine (200) for playing back and processing the DVD-Video contents (10), which reads on the claimed, "a module manager operable to select, based on an index table, a title to become a current title from among a plurality of titles," as disclosed at paragraph [0088];

ENAV engine (300) for playing back and processing ENAV contents (30) and/or (30W), which reads on the claimed, "a module operable to execute the application," as disclosed at paragraph [0088]; and,

the DVD-Video player reads the ENAV playback information prior to the ENAV contents data body (if an ENAV playback control method is read and stored in a memory in advance, a process of the ENAV contents data body can be started without any delay when the ENAV contents data body is read), which reads on the claimed, "the module, when a selection of the current title is made, reads to the cache the file shown in the cache management information in the operation mode object corresponding to the current title, before audio-visual playback of said title commences," as disclosed at paragraph [0073].

Further, the remaining limitations of the claim (lines 6 through 17) are rejected in view of the explanation set forth in claim 15 above.

Regarding **claim 17**, the examiner maintains that the claim is merely the corresponding recording method to the recording medium of claim 15, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 15 above.

Regarding **claim 18**, the examiner maintains that the claim is merely the corresponding method to the apparatus of claim 16, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 16 above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC DAZENSKI whose telephone number is (571)270-5577. The examiner can normally be reached on M-F, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/MARC DAZENSKI/
Examiner, Art Unit 2621